

7-16-04

A19/3727
JFW

PTO/SB/17 (10-03)

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 220

Complete if Known

Application Number	09/927,692
Filing Date	
First Named Inventor	Stephan; Gerard
Examiner Name	Mai; Tri
Art Unit	3727
Attorney Docket No.	STEPHAN-ADAPTER

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit Account Number
Deposit Account Name

23-0120

Alfred Walker

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$) 0

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		-20** =		X		=	
Independent Claims		-3** =		X		=	
Multiple Dependent						=	

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$) 0

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	55
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	165
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 0

SUBMITTED BY

(Complete if applicable)

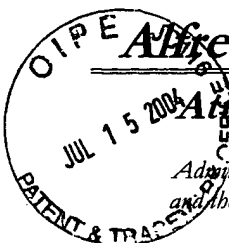
Name (Print/Type)	Alfred Walker	Registration No. (Attorney/Agent)	29,983	Telephone	631-361-8737
Signature	<i>Alfred Walker</i>	Date	July 15, 2004		

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July 15, 2004

Commissioner for Patents
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Alexandria, VA 22313-1450

APPLICANT:	Gerard Stephan
SERIAL NO.:	09/927,692
FILED:	August 10, 2001
EXAMINER:	Tri M. Mai
GROUP ART UNIT:	3727
NOTICE OF APPEAL:	May 11, 2004
TITLE:	NIPPLE ADAPTER FOR BEVERAGE CONTAINER

Dear Sir:

Enclosed please find:

- a) Appeal Brief in Triplicate.
- b) Please extend the time to respond one month and deduct the extension fee of \$55 from Applicant's Attorney's Deposit Account No. 23-0120.
- c) Please deduct the \$165 appeal fee from Applicant's Attorney's Deposit Account No. 23-0120.
- d) Certificate of Mailing.

Respectfully submitted,

Alfred M. Walker
Reg. No. 29,983

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Date: July 15, 2004

Alfred Walker



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN RE APPLICATION OF: Gerard Stephan
SERIAL NO.: 09/927,692
FILED: August 10, 2001
EXAMINER: Tri M. Mai
GROUP ART UNIT: 3727
NOTICE OF APPEAL: May 11, 2004
TITLE: NIPPLE ADAPTER FOR A STANDARD NARROW-
MOUTHED BEVERAGE BOTTLE

Commissioner of Patent
Mail Stop Board of Appeals and Interferences
PO Box 1450
Alexandria VA 22313-1450

APPEAL BRIEF

This is an appeal from the final rejection of the Examiner dated April 6, 1999 rejecting all of the pending claims in the above-identified application. This Appeal Brief is accompanied by the requisite fee set forth in 37 C.F.R. S 1.17(f).

REAL PARTY IN INTEREST (37 C.F.R. 5 1.192(c)(1))

The real party in interest is inventor Gerard Stephan.

07/19/2004 HALI11 00000036 230120 09927692

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RELATED APPEALS AND INTERFERENCES (37 C.F.R. S 1.192(c)(2))

There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee, which will directly affect or be directly affected by, or have a bearing on, the Board of Patents Appeals and Interferences' decision in the above captioned appeal.

STATUS OF CLAIMS (37 C.F.R. 9 1,92(c)(3))

The application was filed on August 10, 2001 with 3 claims. Claim 1 was the only independent claim.

All of the claims were rejected in the Examiner's Office action dated August 1, 2002.

In Applicant's response dated September 6, 2002, Claims 2 and 3 were canceled and Claim 1 was amended. New Claims 4 and 5 were added.

Claims 1, 4 and 5 were subject to final rejection in the Office Action of November 19, 2002.

A Notice of Appeal as filed on May 19, 2003 with a request for extension.

Claims 1, 4 and 5 were amended in a preliminary Amendment accompanying a Request For Continued Examination (RCE) filed June 21, 2003. In response to a Notice of Non-Compliant Amendment, Claims 1, 4 and 5 were re-submitted in a Supplementary Amendment

dated June 15, 2003. A second supplemental Amendment was filed on November 14, 2003 inserting canceled claims 2 and 3.

All of the pending claims, namely claims 1, 4 and 5 were rejected under 35 U.S.C. 103 in an Office Action dated February 12, 2004. The rejection was non-final.

The status of the claims can be summarized as follows:

Claims 1, 5, 14 and 15 are pending

Allowed claims: None

Claims objected to: None

Claims rejected: 1, 4 and 5.

The pending claims are annexed as in Appendix A.

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STATUS OF AMENDMENTS (37 C.F.R. 9 1.192(c)(4))

The applicant has not filed an amendment in response to the Pending Office Action of February 12, 2004.

SUMMARY OF THE INVENTION (37 C.F.R. 1.192(c)(5))

The present invention teaches the usage of an annular adapter which adapts a standard beverage bottle, such as a plastic water bottle, to accommodate the internal threads of a baby's annular nipple cap, which has a nipple inserted therein. Inside the annular adapter is a seal, such as a disc-shaped annular ledge extending in a plane perpendicular to the axis of the adapter, to prevent leakage, when a baby bottle nipple and

cap are inserted over the exterior threads of the annular adapter. Liquid flows through a the central opening of the annular adapter. The nipple is inserted and the seal engages the bottle of the water bottle, the annular adapter is screwed over a conventional threaded exterior neck of a standard beverage bottle, such as a water bottle.

Claims 1, 4 and 5 of the present application were rejected as anticipated by and/or obvious over United States Patent 6,415,937 of DeJong. The cited art of DeJong does not have a single top chamber, but instead has many extra lips and annular rings. The Examiner has stated that if all of those accessories are eliminated, the result is the simpler configuration of the present invention.

However, in the present invention, the upper chamber is uninterrupted by a second inner upper chamber. Moreover, the sealing flange of the present invention is completely flat. Thus, Applicant has argued that DeJong's multiple chambers and slanted walls create different fluid flows from that of the present invention.

Claim 1, as presently amended, recites that the top chamber is uninterrupted, has an inner smooth cylindrical wall and a larger diameter than the bottom chamber. Since the adapter is designed to be used on narrow opening bottles, the larger top chamber provides a reservoir for a smoother flow pattern. In DeJong '937, the upper chamber 62 (see Fig. 4) is Venturi shaped

and would not be likely to provide the type of flow obtained in the present invention.

Consequently there are both structural differences between Applicant's adapter and that of DeJong, as well as unexpected beneficial fluid flow configurations directly related to the improved (and not just structurally simplified) non-Venturi fluid flow configuration of Applicant's adapter.

ISSUES (37 C.F.R. 1.192 (C) (6))

Whether Applicant's simplification of a complicated configuration of the prior art of DeJong is non-obvious?

Whether Applicant's fluid flow path is a non-obvious improvement over the prior art?

Whether secondary considerations overcome the cited art of DeJong?

GROUPING OF CLAIMS (37 C.F.R. 9 1.192(c)(7))

Claims 1, 4 and 5, stand or fall together. Although Claim 4 is a distinct independent claim, to expedite this appeal, Applicant requests that Claims 1, 4 and 5 be reviewed together.

ARGUMENT (37 C.F.R. 1.192 (C) (8):

As previously noted, the present invention's usage of an upper chamber that is uninterrupted by a second inner upper chamber, and completely flat sealing flange create improved fluid flows over the cited prior art.

It has long been held that even if all elements are old, a new result, an unexpected result, a far more efficient result, or a more economical result will satisfy the requirements of patentability. *Higley v Brenner* (1967) 128 App DC 290, 387 F2d 855, 155 USPQ 481.

Moreover, although the pending claims 1, 4 and 5 are not rejected as being anticipated by any single patent, it should be noted that the present invention solves a problem which was previously not solved by the prior art.

[See *Dowless v Hooks* (1954, DC NC) 125 F Supp 96, 102 USPQ 386: "Prior patent which fails to solve problem to which inventor's efforts are directed does not anticipate subsequent patent which successfully solves problem;" and *Bourns v Edcliff Instruments* (1954, DC Cal) 125 F Supp 503, 103 USPQ 369: "Prior patent is no anticipation where it does not solve problem solved by subsequent patent."]

Additionally, the Federal Circuit has held that a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed

invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F2d 1540, 220 USPQ 303 (Fed Cir 1983), cert den 469 US 851. Thus, although DeJong is not cited with any other prior art in the obviousness rejection, applicant can argue that the complete disclosure of DeJong teaches away from the usage of a single chamber as in the present invention.

Obviousness / Simplicity of Invention:

Although the improvement taught by the present invention is relatively simple in nature, such is not valid grounds for rejection as obvious. It has been held that a patent will be held valid where simplicity of invention gives it false appearance of obviousness after event, in light of patent's own teaching. *Shumaker v. Gem Mfg. Co.* (1962 CA7 Ill) 311 F2d 273.

[See also *Application of Aufhauser* (1968) 55 Cust & Pat App 1477, 399 F2d 275: "Viewed after the event, his invention might appear to have been simple, and as such, obvious to those of ordinary skills in this art, but this was not a basis upon which to reject the claims, and where the invention for which a patent was sought solved a problem which had persisted in the art, one had to look to the problem as well as to its solution in order to properly appraise what was done, and to evaluate it against what would be obvious to one having the ordinary skills of the art."]

Obviousness / Secondary Factors:

Applicant has also achieved factors of non-obviousness pursuant to *Graham v. John Deere Co.* U.S. 1, 148 USPQ 459 (1966). It has been held that the "signposts of non-obviousness include the long felt need for such a device which was not theretofore available, its fairly instant commercial success, copying by the defendants, and a new, useful and unique permutation of various prior art combined into a subject matter as a whole which was previously unobvious." *Maclaren v. B-I-W Group Inc.*, 401 F. Supp. 283, 187 USPQ 345 (S.D.N.Y. 1975).

In the present case, the prior art's failure to create optimal fluid flow in itself establishes that the solution of the present invention was not obvious to those skilled in the art. This deficiency of the prior art also establishes a need for such a solution.

In a particular District Court ruling on the issue of obviousness in "streamlining" components, it was first held that patents on molded components for a phonograph stylus, substituting for separate prior art components in a simpler construction that is cheaper and more efficient, were valid over the prior art. *Kabushiki Kaisha Audio-Technica v. Atlantis Sound, Inc.* (1979 DC Va) 203 USPQ 1083.

This ruling was overturned on appeal in *Kabushiki Kaisha Audio-Technica v. Atlantis Sound, Inc.*, 629 F2d 978, 207 USPQ 809

(1980), wherein the Court invalidated the patents-in-suit as obvious modifications to those of ordinary skill in the art, in light of the cited reference.

However, the holding in *Kabushiki* is limited to the unique facts and circumstances, and not applicable to the facts and law herein.

For example, in the patents in question in *Kabushiki*, namely US Patent Nos. 3,761,647 of Nemoto et al and 4,075,418, also of Nemoto et al, (referred to hereinafter as "Audio patents") the subject matter was a unitary molded phonograph stylus for playing phonograph records. However, the novelty was not a change in structure (such as Applicant's eliminating parts and providing better fluid flow, as in the present invention,) but rather a mere substitution of mechanically assembled parts of a cantilevered stylus into a single unitary molded stylus of substantially the same configuration.

In overturning the District Court's finding of non-obviousness, the Fourth Circuit Court of Appeals stated about the District Court's findings :

"The court found that replacing five components of the piano wire assembly with a single plastic device resulted in economy, simplicity, and uniformity of manufacture and replacement. It concluded that the construction of a unitary piece that performed the functions of multiple pieces was not obvious."

The Fourth Circuit Court of Appeals then proceeded to rely upon a prior art U.S. Patent No. 3,230,317 of Friese, which

earlier taught making a unitary molded stylus in lieu of an assembled, multi-component stylus.

The Court stated "The scope and content of the prior art, as revealed by Friese, embrace the fabrication of alternative types of assemblies to serve the same purpose... The purpose of the four assemblies is essentially the same - to enable the stylus and its associated parts to respond to the configurations of the grooves of a phonographic record so the recorded music can be reproduced. In the limited context of this case, the differences between Friese and the claims at issue are not substantial....In sum we conclude that the differences between the unitary mold type of stylus assembly as defined in the claims at issue and the prior art shown in the Friese patent by its disclosure of a unitary mold type of stylus assembly demonstrate that the subject matter of the Audio patents would have been obvious to a person having ordinary skill in the art."

The unitary stylus of Nemoto et al was essentially the same stylus as assembled from separate parts in Nemoto et al, and the novelty of producing a unitary molded stylus was already described in the prior art of Friese.

In contrast to the mere substitution of a multi-component assembly with that of a unitary assembly, as in the patents of Nemoto et al cited in *Kabushiki*, in the present invention, there are different structural configurations which occur in the subject matter of the present invention, which have the

beneficial effect of better, uninterrupted fluid flow because of the elimination of the unnecessary parts described in DeJong.

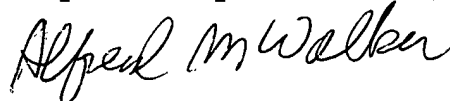
Conclusion

It has been shown that the rejections of Claims 1, 4 and 5 do not properly lie and, accordingly, this Board should reverse the Examiner and allow these claims.

Dated: July 15, 2004

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Respectfully submitted,

A handwritten signature in cursive script that reads "Alfred M. Walker".

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Reg. No. 29, 983
Attorney for Applicant

APPENDIX (37 C.F.R. 1.192(C) (9))

The pending Claims 1, 4 and 5 read as follows:

1. An integral single piece adapter ring with internal female and external male threads, for adapting a conventional baby bottle nipple-and-collar to fit a conventional narrow-mouthed threaded beverage bottle top, said adapter comprising:

a cylindrical ring (2) having an internal void (3) therein;
said female threads located on an inner wall (4) of said ring (2);

said female threads for mating with respective male bottle-top threads of a conventional narrow-diameter threaded-cap beverage container (8), said female threads on said inner wall (4) for permitting alternate user mounting and user removal of said cylindrical ring (2) respectively onto and from said conventional beverage bottle (8);

said cylindrical ring (2) having said external male threads on an outer wall of said ring (2); said male threads for alternate user mounting and removal respectively onto and from respective internal female threads on a conventional baby-bottle nipple collar (6);

an unbraced, unencumbered resilient circumferential sealing flange (5), said sealing flange being completely flat on its

respective top and bottom surfaces, said sealing flange extending radially inward from said inner wall of said ring (2);

said completely flat sealing flange (5) having a central aperture for permitting fluid flow to a conventional baby-bottle nipple (7) therethrough; said completely flat sealing flange (5) sealably contacting an upper edge of the conventional beverage bottle spout when said cylindrical ring (2) and said conventional baby-bottle collar are in their respective mounted positions; and

an uninterrupted top chamber above said sealing flange (5) and a bottom chamber below said sealing flange (5), said top chamber having a smooth, cylindrical interior wall and a diameter larger than the diameter of said bottom chamber.

4. (currently amended) An integral, single piece adapter for adapting a baby bottle nipple for use on and with a narrow-mouthed threaded beverage bottle top comprising:

a circular ring divided in the interior thereof into an uninterrupted top chamber and a bottom chamber by an inwardly extending unbraced, unencumbered resilient sealing flange, said unbraced, unencumbered sealing flange being completely flat on respective top and bottom surfaces thereof for engaging and sealing a top opening of said beverage bottle top, said completely flat sealing flange having an opening for passage of liquid;

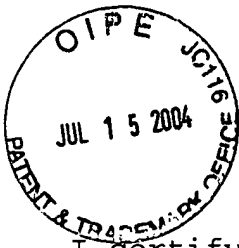
said top chamber having an uninterrupted recess therein and a smooth cylindrical interior wall surface;

female threads being provided along an inner surface of said bottom chamber for engaging threads on the outside of said beverage bottle top;

a collar formed on the outside of said ring adjacent a lower opening into said bottom chamber; and

male threads on the outside of said ring above said collar for engagement with a collar accommodating said nipple therein.

5. The integral, single piece adapter of claim 4 in which said top chamber has a larger inside diameter than said bottom chamber.



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Date: July 15, 2004

Alfred M. Walker
Alfred Walker

7-15-04 stephan appeal brief